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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/759,108	12/02/1996	JIAN QIN	12.975	6757

23556 7590 11/20/2003

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

db32

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	08/759,108	QIN ET AL.	
	Examiner	Art Unit	
	Judy M. Reddick	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08/21/01;09/03/03.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2 and 4-34 is/are pending in the application.
- 4a) Of the above claim(s) 17-32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All   b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

**Response to Arguments**

1. In view of Counsel's persuasive arguments contained in the Appeal Brief filed on 09/03/03, the rejection based on International Application WO 96/17681 is herein withdrawn. However, New Art has come to the Examiner's attention and a rejection based on such is deemed proper and is as set forth infra. PROSECUTION IS HEREBY REOPENED. An apology is extended to applicants for any inconvenience that this may have caused. During a telephone conversation with Mr. Sebastian C. Pugliese III, Counsel for applicants, on November 11, 2003 an attempt to place the case in condition for allowance was made. However, due to time constraints and agreement was not reached.

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7, 9, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) The recited "----ethylene maleic anhydride copolymer-----and copolymers comprising at least two of the preceding polymers" per claim 7 constitutes indefinite subject matter as per it not being readily ascertainable via any known rules of chemistry that would permit "copolymers to comprise polymers". Further, it is suggested that a "hyphen" be inserted between "ethylene" and "maleic".

B) The recited "wherein the basic material is a water-swellaable, water-insoluble polymer" per claim 9/8 constitutes indefinite subject matter as per it not being readily ascertainable as to how such further limits the antecedently recited "basic material" per claim 8. It is suggested that claim 9 depend from claim 1.

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C) In claim 12 @ line 2, it is suggested that "grams per gram of absorbent composition" be inserted after "20" so as to maintain claim language consistency.

#### Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 2, 4-16 & 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-68 of copending Application No. 10/006,781. Although the conflicting claims are not identical, they are not patentably distinct from each other because the absorbent composition comprising an acidic, water-swellaable, water-insoluble polymer having at least about 50 molar percent of its acidic functional groups in free acid form; and a basic neutralization agent; wherein the absorbent composition exhibits a free swell absorbency of at least 15 g/g and an Absorbency Change of greater than or equal to 15% upon saturation per the claims of U.S. copending application no. '781 overlaps in scope with the absorbent composition comprising a mixture of a) an acidic water-swellaable, water-insoluble polymer having a pKa between about 2 and about 12 wherein the acidic water-swellaable, water-insoluble polymer comprises acidic functional groups and has at least about 50 molar percent of the acidic functional groups in free acid form; and b) a basic material; wherein the absorbent compositions exhibits a Free Swell value that is at least about 15 grams per gram of absorbent composition and a Time to Reach 60 Percent of Free Swell Capacity value of at least about 5 minutes and wherein the mixture is not a molecular level dispersion of the acidic water-swellaable, water-insoluble polymer and the basic material per the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

**Election/Restrictions**

6. Claims 17-32 and 34 stand withdrawn from further consideration by the Examiner as per having been drawn to a nonelected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR  
11.17.03